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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,150	02/13/2002	Yasushi Yamade	325772027900	5457
7590	04/07/2005		EXAMINER	
Barry E. Bretschneider Morrison & Foerster LLP 2000 Pennsylvania Ave., N.W. Washington, DC 20006-1888			REILLY, SEAN M	
			ART UNIT	PAPER NUMBER
			2153	

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/073,150	YAMADE, YASUSHI
	Examiner	Art Unit
	Sean Reilly	2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 13 February 2002.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-12 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-12 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 13 February 2002 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is a first action on the merits of this application. Claims 1-12 are presented for further examination.

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed. The effective filing date for the subject matter defined in the pending claims in this application is 3/13/2001.

Specification

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are

replete with grammatical and idiomatic errors. At least the following issues have been noted below.

5. Regarding independent claims 1, 6, and 9, *inter alia*, the limitation “which the first transmission mode is designated in place of the first transmission mode” is infinite. The limitation is ignored since it doesn’t make any sense to replace a transmission mode with the same transmission mode.
6. In further considering claims 1, 6, and 9, *inter alia*, it is unclear when the third transmission mode is *set* (Claim 1, setting means or Claim 6, setting the third transmission mode). It is presumed that the third transmission mode is *set* (selected) when both e-mail and file transfer modes are specified.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 9-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
8. Regarding claims 9-12, since the claimed computer program product of claims 9-12 is not necessarily tangibly embodied on a computer readable medium, it is merely a manipulation of abstract ideas and thus directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-3, 6, 9, and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Kakimoto (U.S. Patent Number 6,775,688).

10. Regarding claims 1, 6, 9, and 12, Kakimoto discloses a method for use with a data transmission device, comprising the following steps of:

- receiving an instruction (Data Distribution Method Figure 5, Component 47) to designate for each destination (for multiple destinations see Figure 4) one of a first transmission mode in which a file is sent attached to an e-mail message (Col 2, lines 12-17 or Col 8, lines 23-28), a second transmission mode in which a file is sent to a file transfer server (real data Col 2, lines 8-11 or Col 8, lines 23-28) and a third transmission mode in which a file is sent to a file transfer server and an e-mail message having a text string including address information of the file transfer server is sent (Link) (Link data transfer Col 2, lines 4-7 or Col 8, lines 23-28) (also refer to Figure 6A);
- determining during multiple-destination delivery in which multiple destinations are designated whether or not the destinations include those for which the first transmission mode is designated as well as those for which the second transmission

mode is designated (Data Distribution Method Figure 5, Component 47 or Col 8, lines 23-28) (also refer to Figure 6A); and

- setting the third transmission mode for the destinations for which the first transmission mode is designated in place of the first transmission mode when it is determined that the destinations include those for which the first transmission mode is designated as well as those for which the second transmission mode is designated (Data Distribution Method Figure 5, link data selected, also refer to Figure 6A).

11. Regarding claim 2, Kakimoto discloses data generating means for generating image data, and wherein the file to be sent comprises the image data generated by the data generating means (Col 7, lines 1-4 and Figure 6A Convert to distributable data form).

12. Regarding claim 3, Kakimoto discloses an image reader for reading an image of an original document and outputting image data, and wherein the file to be sent comprises the image data output by the image reader (Col 7, lines 1-4 and Figure 6A Convert to distributable data form).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 4-5, 7-8, and 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kakimoto.

Regarding claims 4, 7, and 10, Kakimoto discloses the file transfer server address information includes an address of the server and a name of the folder in which the file is to be stored (Data Location, Figure 8 and Col 10, line 66 – Col 11, line 17). However Kakimoto fails to specifically recite that the file transfer server is an FTP server. Nevertheless Kakimoto does not restrict the type of file server which can be used (Col 4, lines 62-64). Examiner takes official notice that FTP file servers were well known file servers in the art at the time of the invention. It would have been obvious to one of ordinary skill in the art at the time of the invention to use an FTP file server within the Kakimoto invention since it utilizes an efficient widely used file transfer protocol.

Regarding claims 5, 8, and 11, Kakimoto fails to specifically recite that the text string of the e-mail message in the third transmission mode includes a user ID and password for authentication purposes. However Kakimoto disclose the file transfer server has an access authority authentication function (Col 12, lines 52-56). Further it was well known in the art at the time of the invention to use a user ID and password for authentication purposes. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to include a user ID and password within the text string of the e-mail message (link data in Kakimoto) in order to provide a user access to the secure file server.

Conclusion

14. The prior art made of record, in PTO-892 form, and not relied upon is considered pertinent to applicant's disclosure.

15. This office action is made **NON-FINAL**.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean Reilly whose telephone number is 571-272-4228. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

3/30/2005



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